

Inventing the Future 2012

Technology Commercialization: Licensing and Manufacturing Insights

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Licensing Tips – Why License

- Introduce intellectual property into company
 - Facilitates launch of product(s)
 - Avoid infringement/strengthen patent portfolio
- Expand use of your intellectual property
 - Value in a different industry
 - Foreign market penetration
- Universities can be a good resource for IP

Licensing Tips – Beyond Monetization

- Rights granted
 - Exclusive vs non-exclusive
 - Access to source code
 - Know-how
- Prohibition of use/fields of use
 - Product type
 - Regions
- Transfer or sublicense rights



Licensing Tips – Beyond Monetization

- Warranties
 - IP versus product
- Limitation on liabilities
 - Conditions licensor is reasonable
- Indemnification
 - Obligation of the parties to “cover cost”
 - IP infringement
 - Product ‘failure’



Licensing Tips – Things to Consider

- Monitoring compliance can be burdensome
 - Development
 - Sales/royalty payments
- Enforcement
 - Joinder
 - Can be difficult...and expensive

Licensing Tips – Things to Consider

- Control
 - Assignability
 - Quality control (on products)
- Use of counsel
 - IP attorney for IP
 - Contracts attorney for contracts

Manufacturing Tips

- Consider IP protection
 - Not only where you will sell, but where you will manufacture
- Export control compliance
- Ensure consistent with license terms



Manufacturing Tips

- Universities are usually not a manufacturer
 - Specialized equipment can be available but...
- Look for private/public partnerships
 - Global Center for Medical Innovation